IN THE

Supreme Court of the United States

OCTOBER TERM, 1963

No. 411

ALEXANDER R. SURREY and GEORGE Y. LESHER,
Petitioners,

v.

DAVID L. LADD, Commissioner of Patents,
Respondent.

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF CUSTOMS AND PATENT APPEALS

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Petitioners pray that a writ of certiorari issue to review the judgment of the United States Court of Customs and Patent Appeals, entered in the above-entitled case on 1963 June 20.

OPINION BELOW

The opinion of the United States Court of Customs and Patent Appeals is reported at 319 F. 2d 233, 138 USPQ 67 and is reprinted in Appendix A hereto.

The opinion refers to a companion case decided the same day. This companion case, *In re Druey, et al.*, is reported at 319 F. 2d 237, 138 USPQ 39 and is reprinted in Appendix B hereto.

JURISDICTION

The judgment of the Court of Customs and Patent Appeals was entered on June 20, 1963. The jurisdiction of this Court is invoked under 28 U.S.C. Section 1256. See discussion of jurisdiction, p. 7, *infra*.

QUESTIONS PRESENTED

1. Whether the United States Court of Customs and Patent Appeals is the "Supreme Court" on cases arising in the Patent Office and involving patentability questions, or, whether this court has jurisdiction to review, in its discretion on writ of certiorari, a decision of the Court of Customs and Patent Appeals affirming the denial of certain claims by the Patent Office Board of Appeals in an otherwise allowable patent application?

2. Whether the 1952 patent act, in 35 U.S.C. Section 103, made any change in the prior law as to what shall be considered as relevant evidence of patentability of chemical compounds?. The question arises in this manner: There is conflict on the question, between the position of the United States District Court for the District of Columbia, as expressed in 1950 in *Parker v. Marzall*, 92 F. Supp. 736, 86 USPQ 446, and the position of the Court of Customs and Patent Appeals as expressed in 1963 in this case.

3. Whether the invention of a claimed chemical process for preparing an unobvious chemical compound X by reacting known compound A with unknown compound B could be, in view of the prior art, held, "—obvious at the time the invention was made to a person having ordinary skill in the art" under 35 U.S.C. Section 103?

STATUTE INVOLVED

35 U.S.C. Section 103:

> Conditions for patentability; non-obvious subject matter
>
> A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

STATEMENT

This proceeding grows out of the rejection by the Patent Office of Claims 10-17 in petitioners' otherwise allowable patent application Serial No. 660,456, filed 1957 May 27, entitled "Aryl N-(Amino-Alkyl)-Carbamates and Their Preparation".

The claims of petitioners application are in three (3) categories: allowed Claims 1-9 directed to chemical compounds being so-called final products. Claims 15-17 directed to novel compounds useful as starting materials, and, Claims 10-14 directed to the process of making such final products using such starting materials.

The Examiner finally rejected starting material Claims 15-17 as unpatentable over Beilstein, 4th ed., vol. 6, page 487 [1923], which discloses a structurally related compound. The Examiner also finally rejected process Claims 10-14 as unpatentable over Cusic U.S.

Patent 2,683,735 which discloses the general type of reaction applied to vaguely "analogous" starting materials. The final rejections of Claims 15-17 and of Claims 10-14 were each affirmed by the Patent Office Board of Appeals and by the majority decision of the Court of Customs and Patent Appeals, one judge dissenting.

The two issues, one involving the process claims and the other involving the starting material (intermediate) products, as presented to and discussed by the Court of Customs and Patent Appeals, are predominantly legal in nature and all technical-chemical aspects are merely incidental. Both issues involve an interpretation of 35 U.S.C. Section 103, which is the section of the Patent Law defining the applicable statutory standard of invention. This section reads, in pertinent part:

> "A patent may not be obtained—if the differences between the subject mater sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains".

ON THE PROCESS CLAIMS ISSUE: Petitioners argued the legal proposition that a novel process for making a patentable final product is patentable under 35 U.S.C. Section 103 where such final product made by the process is conceded to be unobvious and the principal starting material used in the process is unknown.

The majority of the court held

> "Here we have process claims which define simply 'reacting' a particular chloroformate [starting

material B] with a particular amine [starting material A] to produce a particular carbamate [final product X]. That type of reaction is admittedly old. The appealed claims recite no unobvious or critical limitation which might serve to distinguish them from the prior art. The only distinction is that the particular chloroformates, [starting material B]- and consequently the resulting carbamates [final products X] are new. Mere novelty of one of the reactants, which is the only novelty alleged here, does not render an otherwise conventional chemical process patentable, since it does not impart anything to the process which is unobvious to one skilled in the art. It constitutes no more than an obvious application of an old process to new compounds." [Matter in brackets added.]

Judge Smith dissented. He said:

"The appealed process claims cover a process in which, at the time the invention was made, (1) the end product was *unknown*, and (2) one of the reactants in the process was *unknown*. The claimed process does require selection of two starting materials, (one of which was *unknown* in such a process at the time the invention was made), to make a product, (which also was *unknown* at the time the invention was made). The claimed process thus requires two *differences* over the prior art as shown by the Basic reference. These *differences* in my opinion are not obvious within the meaning of 35 U.S.C. 103."

ON THE STARTING MATERIAL PRODUCTS ISSUE: Claims 15-17 were rejected as being unpatentable over the reference to Beilstein which discloses a compound structurally differing from the claimed starting materials, but related thereto by having the same chemical moieties arranged in a different manner.

It is well established patent law and practice to permit an applicant for a patent to demonstrate conclusively the unobviousness and patentable inventiveness of his claimed chemical compound by showing it possesses unexpected, advantageous properties which the cited reference compound does not possess. *In re Papesch*, 50 C.C.P.A. , 315 F. 2d 381, 137 USPQ 43. This evidentiary comparative "—showing of unexpected properties", which is customarily presented in the form of affidavits, must be based on properties previously referred to in applicants' patent specification, else it cannot be accepted as the proper type of proof of unobviousness required to overcome the reference. *In re Stewart*, 42 C.C.P.A. 937, 222 F. 2d 747, 106 USPQ 115.

In the instant case petitioners presented a comparative affidavit which they contended demonstrates their claimed starting material possesses unexpected properties. The Court held petitioners' showing was improper in that they did not submit a showing of the "properties" of the particular compounds claimed. Petitioners argued they made the only type of showing the case law permits, i.e., they made the specific showing based on the sole utility alleged in the specification for the claimed compounds. *The utility alleged in the specification for these claimed compounds is as starting materials to make the final product compounds, which latter compounds are local anesthetics.* Thus petitioners actually did compare their claimed starting materials with the compounds of the Beilstein reference by showing the properties of the final products made from such starting materials differed from the corresponding final products made from the reference compounds, as to their local anesthetic activity.

The majority of the Court of Customs and Patent Appeals held the affidavits insufficient solely because they did not "relate" to the starting material compounds in issue. The dissent agreed with petitioners' arguments.

Petitioners also argued their position was supported by well-established prior case law, i.e., by *Parker* v. *Marzall* (D.C. D.C. 1950) 92 F. Supp. 736, 86 USPQ 446, a case decided before the present 1952 Patent Act by the "other" court also having appellate type jurisdiction over the Patent Office Board of Appeals. This case had heretofore been cited with approval on a number of occasions by the Court of Customs and Patent Appeals. The majority referred to its concurrent decision in *In re Druey;* 50 C.C.P.A. , 319 F. 2d 237, 138 USPQ 39, Appendix B, wherein it discussed the *Parker* v. *Marzall* case, but refused to apply it, notwithstanding the protests of the dissenting judge.

JURISDICTION

At the outset of this case is an important and unresolved question as to this Court's jurisdiction to review this or any patent case decided by the Court of Customs and Patent Appeals.

That the question of jurisdiction exists is evidenced by *Glidden Co.* v. *Zdanok*, 370 U.S. 530, 579, 8 L. ed. 2d 671, 704, 82 S. Ct. 1459, where the Court, in discussing the nature of Court of Customs and Patent Appeals proceedings, said in a footnote:

> "49. We intimate no opinion whether 28 USC Sec. 1256 was intended by Congress to make patent and trademark cases reviewable by certiorari in this court."

The Court will appreciate the patent bar is in a quandary as to whether the time, effort, and expense of filing petitions for certiorari such as this is warranted. The patent bar would like to know which court is its "Supreme Court".

The jurisdiction question arises as follows:

In a series of cases beginning with *Postum Cereal Co.* v. *California Fig Nut Co.*, 272 U. S. 693, this Court held that neither patent nor trademark decisions of the nature then determinable by the Court of Customs and Patent Appeals are reviewable in this Court. See also *Pacific Northwest Canning Co.* v. *Skookum Packers' Assn.*, 283 U.S. 858 (a trademark case); *McBride* v. *Teeple*, 311 U.S. 649 (a patent case). The following reasons were given: (1) since the Court of Customs and Patent Appeals decisions do not have a binding effect on the question of trademark or patent validity, they are not of such nature as to be reviewable by this Court under its Article III jurisdiction; (2) the Court of Customs and Patent Appeals proceedings are administrative in nature and are not "cases" or "controversies" within the meaning of Article III; and (3) the absence of any statutory authorization for review of such proceedings by this Court.

Petitioners submit all of the foregoing reasons have either disappeared or are inapplicable in this case and this Court possesses full power to review the decision below.

(1) In this case, the Court of Customs and Patent Appeals determined certain claims in the patent application should be denied and hence there will be no claims as to which the validity can be called into ques-

tion in another court at another time. Moreover, in *Hoover Co.* v. *Coe*, 325 U.S. 79, and in *Special Equipment Co.* v. *Coe*, 324 U.S. 370, this Court granted full review of District Court patent proceedings even though the District Court judgments had no more binding effect on the issue of validity than do judgments of the Court of Customs and Patent Appeals. These two subsequent decisions indicate an abandonment of the no-binding-judgment argument advanced in the *Postum* case. See Robertson and Kirkham, Jurisdiction of the Supreme Court of the United States (Wolfson and Kurland ed.) Section 251, pp. 442-448; Gilbert, The Constitutionality of Supreme Court Review of Patents and Trademark Decisions of the Court of Customs and Patent Appeals, 45 Geo. L.J. 645; 48 T.M.R. 8.

(2) The decisions of the Court of Customs and Patent Appeals can no longer be considered as administrative in nature. That tribunal in 1958 was accorded the status of "a court established under article III of the Constitution of the United States," 72 Stat. 848, 28 U.S.C. Section 211, and its judgments must be considered to be judicial pronouncements on cases and controversies. The parties before it act in a truly adversary capacity and the court interprets and applies the legislative standards prescribed by Congress in rendering its decisions.

Further, the judges of the Court of Customs and Patent Appeals are now treated the same as circuit judges and district judges under 28 U.S.C. 293, in that they may be temporarily assigned interchangeably.

(3) This Court now has full and unconditional statutory authority to review any and all decisions of the

Court of Customs and Patent Appeals. The 1948 recodification of the Judicial Code plainly states: "Cases in the Court of Customs and Patent Appeals may be reviewed by the Supreme Court by writ of certiorari." 28 U.S.C. Section 1256. This unambiguous provision indicates no legislative intent to confine review to any particular type of case or to exclude either patent or trademark cases. Also, Rule 19 of this Court's rules provides that the same general considerations governing review of decisions of the Courts of Appeals "will control in respect of petitions for writs of certiorari to review judgments of the Court of Claims, of the Court of Customs and Patent Appeals, or of any other court whose determinations are by law reviewable on writ of certiorari."

The foregoing factors combine to make evident the existence of jurisdiction in this Court to review the judgment below.

REASONS FOR GRANTING THE WRIT

1. The Question of the Jurisdiction of This Court to Review on a Writ of Certiorari a Decision of the Court of Customs and Patent Appeals in a Patent Case Is An Important Question Which Ought to be Decided Now

The answer to the jurisdiction question ought be announced by this Court so that applicants for a patent may know where they must look for their *final* interpretation of the patent laws. In recent years patent applicants have felt a bit like stepchildren who suspect, but are not sure, they are unloved and unwanted. This Court has refused to clarify their status to appear before it. Yet it is not a small group who are concerned. Over 70,000 patent applications are filed each year. In processing each patent application the question of

proper application of the standard of patentability is directly involved. This Court has said: "The standard of patentability is a constitutional standard;" *Great A. & P. Tea Co.* v. *Supermarket Equip. Corp.*, 340 U.S. 147, 155. Who is the final interpreter of this constitutional standard? If there be no possibility of review of patent decisions of the Court of Customs and Patent Appeals, then that court is, in effect, the actual "Supreme Court" in at least 70,000 instances per year, and all applicants and several thousand members of the patent bar must regard this Honorable Court as impotent to enunciate guide-line doctrines.

2. The Decision Below Has Improperly Decided an Important Question of Federal Law Which Has Not Been, But Should Be, Settled By This Court

The decision below decides a fundamental question of the application and interpretation of what is perhaps the most important single section of the patent statute, 35 U.S.C. Section 103, which states the "standard of invention" to be applied in determining patentability. This section of the patent statute has never been interpreted by this Court, as it was first introduced in the 1952 Patent Act and had no precursor in previous patent statutes. The rejection by the Patent Office of the process claims in the situation here involved represented a substantial change in the practice of the Patent Office where process claims were usually allowed almost as a matter of course when presented along with allowable product claims. The change in practice actually came slightly earlier, in the *In re Larsen*, 49 C.C.P.A. 711, 292 F. 2d 531, 130 USPQ 209 case relied on by the majority decision. The doctrine of that case has been extended somewhat in the instant

case to apply to situations where one of the starting materials used in the process is novel. The decision in this case will be applicable and controlling in numerous pending and future patent applications, since it is common, in patent applications claiming a novel chemical product, to include process claims. The decision below is a case of first impression. The decision below was by a divided Court. The decision below decides the interpretation of 35 U.S.C. Section 103 by default, since the majority of the Court refuses to be concerned with the question of what is in the prior art which can be considered in deciding what "would have been obvious *at the time the invention was made*" and inferentially gave the terms "time" and "prior art" a meaning inconsistent with the other requirements of that section.

In *Great A. & P. Tea Co. v. Supermarket Equip. Corp.*, 340 U.S. 147, 155, Mr. Justice Douglas pointed out in his concurring opinion that "The standard of patentability is a constitutional standard." Failure of the decision below to consider correctly the language of the provision of the statute which deals with the standard of patentability, makes appropriate the exercise of this Court's certiorari jurisdiction.

3. The Decision Below Shows a Diversity of Interpretation in Two Different Circuits Which Should Be Resolved

An applicant for a patent dissatisfied with the decision of the Board of Appeals may appeal to the United States Court of Customs and Patent Appeals under 35 U.S.C. Section 141 *or* to the United States District Court for the District of Columbia under 35 U.S.C. Section 145. Thus there are two and only two

alternative routes available. It would seem appropriate that the applicable patent law be similarly applied by both courts involved. Yet the instant case presents a conflict.

The Court of Customs and Patent Appeals in refusing to apply the doctrine of *Parker* v. *Marzall* (D.C. D.C. 1950) 92 F. Supp. 736, 86 USPQ 446 in a situation where the dissenting judge said that case "seems to me to be very pertinent as applied to the present facts", has rendered a decision involving an important constitutional standard in a way in conflict with the other circuit.

While *Parker* v. *Marzall* was decided by the District Court rather than the Court of Appeals, since the District of Columbia circuit has but one District Court in it, this case is the authoritative precedent for all future cases involving a similar issue in such circuit.

4. The Decision Below Has Decided a Federal Question in a Way in Conflict With Applicable Decisions of This Court

The decision below decides the question of the patentability of a process to make a patentable product in a way which conflicts with this Court's view of the relationship between the various classes of statutory subject matter which was expressed in *James* v. *Campbell*, 104 U.S. 356, 376 as:

> "A patent for a process and a patent for an implement or a machine are very different things: Powder Company v. Powder Works, 98 U.S. 126. Where a new process produces a new substance, the invention of the process is the same as the invention of the substance. . . ."

CONCLUSION

For the foregoing reasons, this petition for a writ of certiorari to the Court of Customs and Patent Appeals should be granted.

Respectfully submitted,

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September 1963

APPENDIX A

COURT OF CUSTOMS AND PATENT APPEALS

In re SURREY AND LESHER.

Appl. No. 6954

Decided June 20, 1963

Before WORLEY, Chief Judge, and RICH, MARTIN, SMITH, and ALMOND, Associate Judges.

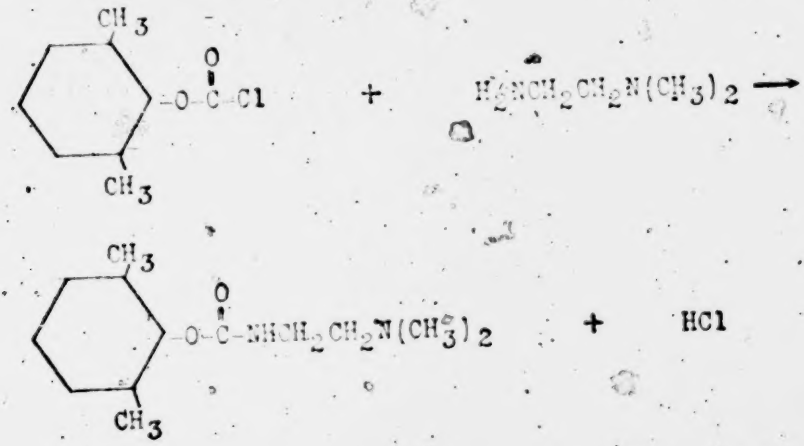
WORLEY, Chief Judge.

This appeal is from the decision of the Board of Appeals, affirming the examiner's rejection of claims 10 through 17 of appellants' application[1] entitled "Aryl N-(Aminoalkyl)-Carbamates and their Preparation" as unpatentable over the prior art. Nine claims were allowed.

The invention relates to (1) certain new carbamates which are useful as local anesthetics, (2) certain new chloroformates which are the intermediates from which the carbamates are prepared and (3) the process of producing the carbamates by reacting the chloroformates with an amine. Illustrative of the invention is the reaction of the intermediate 2,6-dimethylphenyl chloroformate with 2-dimethyl-

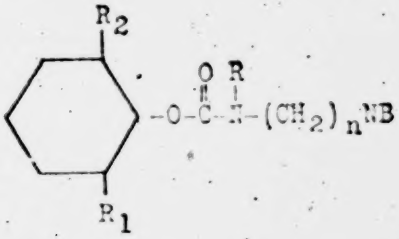
[1] Serial No. 660,456, filed May 21, 1957.

aminoethylamine to make 2,6-dimethylphenyl N-(2-dimethylaminoethyl) carbamate:[2]



Claims 10 and 15 are exemplary of the appealed claims.

10. A process for the preparation of a compound having the structural formula

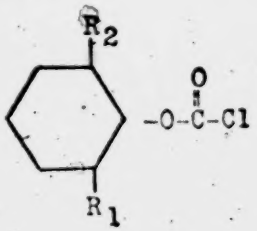


where R is selected from the group consisting of H and CH_3, R_1 and R_2 each represents a member of the group consisting of methyl and ethyl radicals, n represents an integer from 2 to 3 inclusive, and NB is a radical containing from two to twelve carbon atoms and selected from the group consisting of mono-(lower-

[2] This process is claimed in claim 13 and the intermediate in claim 16.

alkyl) amino, monocycloalkylamino, di-(lower-alkyl) amino, 1-piperidyl, (lower-alkylated)-1-piperidyl, 1-pyrrolidyl, (lower-akylated)-1-pyrrolidyl, 4-morpholinyl, 1-piperazyl and alkylated-1-piperazyl radicals, which comprises reacting a chloroformate of the corresponding 2,6-di-(lower-alkyl) phenol with an ethylene-diamine of the formula $RHN(CH_2)nNB$ in which the symbols R, n, and NB each have the respective values above-assigned.

15. A 2,6-dialkylphenyl chloroformate having the structural formula



where R_1 and R_2 each represents a member of the group consisting of methyl and ethyl radicals.

The references relied on are:[3]

Cusic 2,683,735 July 13, 1954
Beilstein, 4th Ed., Vol. 6, pages 487 (1923).

Nine claims drawn to the carbamates were allowed by the examiner "after a showing was presented establishing that there is, for example, an unexpected pharmacological quality possessed by 2,6-dimethylphenyl N-(3)-dimethyl-

[3] The examiner did not describe the references in his Answer, relying for their description on appellants' brief before the board which does not appear in the record. It would be helpful to us if the examiner described the references thoroughly in his Answer so that we might have the benefit of his interpretation and know the exact portions of the references relied on.

aminopropyl) carbamate hydrochloride which is not possessed by 2,4-dimethylphenyl N-(3-dimethylaminopropyl) carbamate hydrochloride. * * * " Rejection of the claims drawn to the process of preparing the carbamates and to the intermediate chloroformate compounds is succinctly stated in the examiner's Answer as follows:

> Claims 10-14, drawn to process, are rejected as being unpatentable over the patent to Cusic which discloses a classic method of preparing carbamic acid esters by the reaction of an amine and a chloroformate. This process is considered obvious in the preparation of the carbamic acid esters on appeal and only the expected result is revealed in applicants' use of this process to prepare the compounds of the allowed product claims. Application of an old process to different but analogous material is not inventive. . . .
>
> Claims 15-17, drawn to intermediary products, are rejected as being unpatentable over the reference to Beilstein which discloses 2,4 dimethylphenyl chloroformate, an isomer of the claimed intermediates.

The board affirmed the rejection of claims 10-14 "for the reasons set forth" by this court in In re Larsen, 49 CCPA 711, 292 F.2d 531, 130 USPQ 209. It affirmed the rejection of claims 15-17, stating that each claim must be considered on its own merits and that unexpected pharmacological properties in a final product do not provide a proper basis for allowance of claims to the intermediate which has been rejected over a prior art isomer, since such a showing does not provide evidence that the intermediate itself possesses any new or unobvious property.

We have two distinct issues here: whether the intermediates were properly rejected as unpatentable over the Beilstein reference, and whether the process claims were properly rejected as unpatentable over the Cusic patent.

With respect to the rejection of claims 15-17 drawn to the intermediate chloroformate compounds, appellants con-

tend only that evidence of the unobvious local anesthetic action possessed by the final products (carbamates) made directly from the intermediates (chloroformates) is sufficient to prove patentability according to the standard set forth in Parker v. Marzall, 92 F. Supp. 736, 86 USPQ 446 (D.C., D.C.).

If the structural similarity between the reference compound and that of the claimed compound establishes a prima facie case of obviousness, then appellants can prevail only if they overcome such prima facie case. Hence, two separate questions are involved: (1) whether a prima facie case of obviousness has been established, and, if so, (2) whether the affidavits presented are sufficient to overcome the prima facie case of obviousness.

The Beilstein reference discloses the compound 2,4-dimethylphenyl chloroformate which the examiner characterized as an isomer of 2,6-dimethylphenyl chloroformate, the compound in claim 16. Appellants point out that the prior art compound is the homolog of the isomer of 2,6-diethylphenyl chloroformate, the compound of claim 17. The examiner supports his holding of obviousness over the Beilstein disclosure with the following rationale:

> • • • Generally, chloroformates are formed by reacting phosgene with xylenols (the hydroxy derivatives of xylenes). *All of the isomeric xylenols are well known in the art.* The chloroformate ester of a 2,4- rather than a 2,6-xylenol is disclosed by Beilstein. • • • (Italics supplied).

Appellants do not challenge the correctness of that reasoning nor the apparent obviousness of the claimed compound; but merely contend that the affidavits of record are sufficient to rebut the examiner's holding. There is no question that the two affidavits concern only the properties of the carbamates and in no way consider the properties of the claimed chloroformates. Under such circumstances we find the affidavits insufficient because they do not relate

to the compounds in issue. The properties of the carbamates are inherent in those compounds, and not in any of the reactants from which they may have been prepared. See our concurrent decision in In re Druey,[4] 50 CCPA —, — F.2d —, 138 USPQ 39. [Appendix B] The rejection of claims 15-17 is *affirmed*.

The Cusic reference discloses a process for preparing carbamate acid esters (carbamates) by heating an aryl chloroformate with an alkalene-diamine in an inert organic solvent. The examiner characterized that reaction as being "a classic method of preparing carbamic acid esters." Appellants admit that Cusic discloses the same type of reaction as claimed, but is applied to different though "somewhat analogous starting materials." They urge the following proposition:

> Claims to a novel process which utilizes a known type reaction for making a patentable final product, ought be allowed where either (a) the final product made by the process is patentable due to non-obvious differences from prior art of the molecular structure, or (b) the principal starting material was unknown at the time the claimed process was invented. Points (a) and (b) serve to distinguish the facts from those of In re Larsen.

Appellants state in their brief that in Larsen this court found:

> "The compounds reacted are conceded to be old"—and—" * * * the allowance of the claims to the compounds (by the examiner) was based on the fact that they possessed unique, and presumably unexpected properties."

Those statements, quoted out of context, do not represent the reasons for the decision in that case. Larsen held that even though the compounds themselves were patent-

[4] Patent Appeal No. 6895.

able, the processes by which they were prepared may or may not be obvious, adding further (130 USPQ at 210) that:

> In view of the obviously close parallel between the claimed processes and those of the references, we agree with the conclusion of the Patent Office that if the compound is recited in appellant's allowed claims were disclosed in the prior art it would be obvious to a person of ordinary skill in the art to prepare them by the processes set forth in the appealed claims. * * *

"It is well settled that the allowability of one set of claims cannot be predicated on the patentability of other claims in the same application." In re Touvay, 46 CCPA 823, 264 F.2d 901, 121 USPQ 265. Claims to a *method* of preparing a chemical compound must be found patentable independently of claims to the compound itself.

If the instant process claims are patentable, they must themselves be unobvious over the prior art. Whatever may have been the reasons for allowance of claims to the carbamate products, whether because of unobvious structure or property, those unobvious features are inherent in the carbamates themselves, and *not* in the method of their preparation, or in the reactants from which they are produced.

Here we have process claims which define simply "reacting" a particular chloroformate with a particular amine to produce a particular carbamate. That type of reaction is admittedly old. The appealed claims recite no unobvious or critical limitation which might serve to distinguish them from the prior art. The only distinction is that the particular chloroformates, and consequently the resulting carbamates, are new. Mere novelty of one of the reactants, which is the only novelty alleged here, does not render an otherwise conventional chemical process patentable, since it does not impart anything to the process which is unobvious to one skilled in the art. It constitutes no more

than an obvious application of an old process to new compounds. From the point of view of the chemical reaction and the reactive groups concerned, the same reaction takes place. We do not find the fact that one of the reactants here is novel but obvious, while the reactants were old in Larsen; sufficient to convince us that a different result from that decision should be reached here. The substitution of the novel chloroformate into the old reaction seems to have produced only expected results. The rejection of claims 10-14 is also *affirmed*.

SMITH, Judge, dissenting.

I disagree with the result reached by the majority as to both the process claims and the product claims.

Process claims 10-14 are not, in my opinion, governed by what the board has found to be "the reasons set forth" by this court in In re Larsen, 49 CCPA 711, 292 F.2d 531, 130 USPQ 209. The present case presents a different factual situation from that in Larsen. In Larsen, the reactants in the process were *old*. Here, to the contrary, a *novel* reactant material is called for in the process of claims 10-14. The appealed process claims cover a process in which, at the time the invention was made, (1) the end product was *unknown*, and (2) one of the reactants in the process was *unknown*. The claimed process thus requires selection of two starting materials, (one of which was *unknown* in such a process at the time the invention was made), to make a product, (which also was *unknown* at the time the invention was made). The claimed process thus requires two *differences* over the prior art as shown by the Cusic reference. These *differences* in my opinion are not obvious within the meaning of 35 U.S.C. 103. I would, therefore, reverse the rejection of the process claims.

As to the product claims 15-17, I dissent from the majority for the reasons stated in my dissent in In re Deuel et al., 50 CCPA —, — F.2d —, 138 USPQ —. [Appendix B].

APPENDIX B

COURT OF CUSTOMS AND PATENT APPEALS

In re DRUEY AND SCHMIDT

Appl. No. 6895

Decided June 20, 1963

Before WORLEY, Chief Judge, and RICH, MARTIN, SMITH, and ALMOND, Associate Judges.

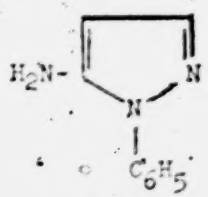
WORLEY, Chief Judge.

Appellants seek reversal of the decision of the Board of Appeals which affirmed the examiner's rejection of one claim in appellants' application[1] entitled "New Amino Benzene Sulfonamide," as unpatentable over the prior art. Six claims directed to the method of producing the compound, defined by the rejected claim, were allowed.

The remaining claim reads:

> 11. A member selected from the group consisting of 3-amino-2-phenyl pyrazole and acid addition salts thereof.

The invention, which is used as an intermediate in the preparation of a sulfa drug, has the following structural formula:



(I)

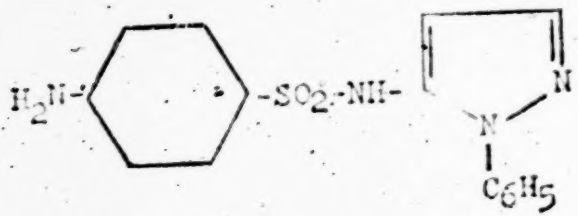
According to undisputed facts, applicants first disclosed the claimed intermediate in a parent application[2] in which

---

[1] Serial No. 702,540, filed December 13, 1957.

[2] Serial No. 656,503, filed May 2, 1957, which has matured into U.S. Patent No. 2,858,308, issued on October 28, 1958, in which only the sulfa drug is claimed.

they also claimed the sulfa drug. As a result of a restriction requirement by the examiner, the instant continuation-in-part application was filed. The sole use disclosed in the specification for the claimed compound is as an intermediate for the preparation of the now patented sulfa drug: 3-(p-aminobenzene sulfonamido)-2-phenyl-pyrazole having the structural formula:



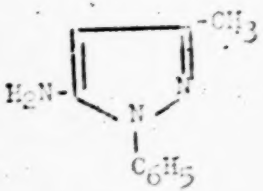
(II)

No other use for said compound is disclosed in the record.

The reference relied on is:

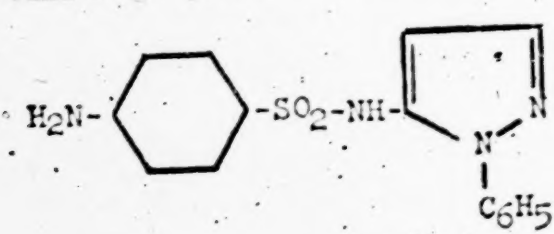
French Patent, 872,801, February 23, 1942.

It is not disputed that the French patent discloses the compound



(III)

and teaches that compound III can be used to prepare the sulfa drug represented by the formula:



(IV)

For convenience we shall identify the compounds by Roman numerals.

The examiner rejected the claimed compound I on compound III of the French patent, considering them to be adjacent homologues, stating:

> Ordinarily a homologue is unpatentable over the old compound in the absence of a showing of unexpected properties in the use disclosed * * *.

During the prosecution of the parent application, sulfa drug II was rejected over sulfa drug IV of the French patent; however, the examiner withdrew that rejection after applicants presented the affidavit of one Dr. Neipp. Consequently, compound II was patented. In an effort to show the unexpected properties of the instantly claimed compound I, applicants submitted the *same* affidavit which they had used in the parent case. That affidavit shows that applicants' sulfa drug, compound II, made from claimed compound I, had a higher and longer lasting chemotherapeutic effect, as well as a much stronger activity against streptococcal sepsis, than the sulfa drug of the French patent, compound IV, which had been made from reference compound III.

The examiner, in commenting on the affidavit, stated:

> The subject matter of the affidavit concerning the sulfa drug is considered too remote to bear upon the patentability or the properties of the intermediate. The affidavit does not concern itself with the subject matter "sought to be patented". This is emphasized by the use of the same affidavit to argue the patentability of two different classes of subject matter.

The board, agreeing with the examiner, held, that despite the asserted superiority of appellants' sulfa compound II over the sulfa compound IV of the French patent, the for-

mer is not "the subject matter sought to be patented"[3] in the present case. Continuing, it stated:

> * * * to whatever extent the asserted superiority may be the basis for patentability, appellants' contribution has been recognized by the granting of Patent No. 2,858,309. The compound before us, however, must shine in its own light, not in the reflected glory of another compound.

The board found appellants' argument that the claimed compound I and reference compound III are not homologues to be inconsistent with statements made during the prosecution of both appellants' parent case, as well as in the instant case.[4] The board stated it was clear that the claimed compound I is the next *adjacent homologue* of compound III disclosed by the French patent, within the scope of that term as allegedly defined by decisions of this court, and concluded:

> In any event, and this is the most important aspect to this matter, we are fully satisfied that the claimed

[3] 35 U.S.C. 103 states in part:

> A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the *subject matter sought to be patented* and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. * * * (Emphasis supplied).

[4] In the prosecution of the instant case, appellants state in their letter of August 29, 1958:

> * * * While the patent may be said to disclose "adjacent homologs" of the claimed compounds, attention is directed to the fact that the sulfonamides formed from the instantly claimed intermediates have been shown to be far superior to sulfonamides formed using the "homologous" methylated pyrazoles of the reference. * * *

compound would be obvious to a person of ordinary skill in this art from knowledge of the compound of the French patent. . . .

We need not decide here whether the compounds in question are properly labeled homologues. It appears to us from the authorities cited by the solicitor and appellants that the term homologue is used by chemists at times in a broad sense, and at other times in a more narrow or strict sense. The name used to designate the relationship between related compounds is not necessarily controlling; it is the closeness of that relationship which is indicative of the obviousness or unobviousness of the new compound. In re Herr, 50 CCPA 705, 304 F.2d 904, 134 USPQ 176. Here the difference is merely the omission of a methyl group from the pyrazole ring. It seems to be well known that a simple pyrazole ring contains no substituents at all. We think those considerations constitute strong evidence that omission of the methyl group from the ring is an obvious variation of the reference compound, thereby establishing a prima facie case of unpatentability of claimed compound I over reference compound III. Hence, if appellants are to prevail, they must overcome the weight of that evidence. Thus, the issue here is whether the affidavit is sufficient to do so or whether the showing therein is too remote.

It is appellants' position that since the only use disclosed for their compound I is as an intermediate for direct production of sulfa compound II, the "best evidence" which may be submitted under the circumstances of this case is a showing of the unexpected property of the sulfa

[1] Standard texts on organic chemistry show pyrazole to be

compound II, as compared to one made from the reference compound III. They contend further that this so-called "best evidence" rule has been embraced by the board in previous decisions, such as Ex parte Parker, 102 USPQ 367, and reaffirmed in Ex parte Brody, 122 USPQ 611, and that the rule which stems from Parker v. Marzall, 92 F. Supp. 736, 86 USPQ 446, was cited by this court with approval in In re Schechter, 40 CCPA 1009, 205 F.2d 185, 98 USPQ 144. However, the solicitor argues, and we agree, that In re Finley, 36 CCPA 998, 174 F.2d 130, 81 USPQ 383, is more in point, and that the standard set forth there requires the verified showing to "relate to the utility of the compound actually being claimed instead of some derivative thereof," and that "if the claimed compound itself is not tested to show superior properties, an explanation as to why it is necessary to test a derivative should be made of record." Appellants have not complied with those requirements.

Appellants have made no showing that the claimed intermediate has any unexpected properties, and have given no reason why the compound itself was not tested. We find no reason why the unexpected therapeutic properties of the sulfa drug should necessarily relate back to the intermediate, or why such properties must necessarily be attributable to one of the reactants from which it was prepared. The record shows that the therapeutic properties here belong to the sulfa drug, not to any of the compounds used in its preparation. Appellants' affidavit, therefore, fails to establish that the claimed compound has any unobvious or unexpected property, hence fails to rebut the prima facie showing of obviousness over the prior art.

The decision is *affirmed*.

SMITH, Judge, dissenting.

I do not agree with what seems to be the underlying concept of the majority opinion. The statement is made in

the opinion that "Appellants have made no showing that the claimed intermediate has any unexpected properties * * *." The majority disposes of the Neipp affidavit since it shows the results of tests of a sulfa drug made from the compound claimed in rejected claim 11 when compared with a sulfa drug made from the compound of the French reference patent.

The majority states:

> * * * We find no reason why the unexpected therapeutic properties of the sulfa drug should necessarily relate back to the intermediate, or why such properties must necessarily be attributable to one of the reactants from which it was prepared. The record shows that the therapeutic properties here belong to the sulfa drug, not to any of the compounds used in its preparation. * * *

The examiner's answer in reference to the compound of appealed claim 11 states that "The compound's only use is as an intermediate for preparation of sulfa drugs." This being true, it seems to me appellants had no choice but to test the claimed compound in its "only use", i.e., in terms of the sulfa drug prepared therefrom. In my opinion, the Neipp affidavit clearly establishes a result which seems clearly to be an unobvious and unexpected result.

As we stated in In re Viktor Papesch, 50 CCPA 1084, 315 F.2d 381, 137 USPQ 43, 51:

> From the standpoint of patent law, a compound and all of its properties are inseparable; they are one and the same thing. The graphic formulae, the chemical nomenclature, the systems of classification and study such as the concepts of homology, isomerism, etc. are mere symbols by which compounds can be identified, classified, and compared. But a formula is not a com-

pound and while it may serve in a claim to *identify* what is being patented, as the metes and bounds of a deed identify a plot of land, the *thing* that is patented is not the formula but the compound identified by it. And the patentability of the thing does not depend on the similarity of its formula to that of another compound but of the similarity of the former compound to the latter. There is no basis in law for ignoring any property in making such a comparison. An assumed similarity based on a comparison of formulae must give way to evidence that the assumption is erroneous.

No useful purpose is here served by reviewing what I think are the pertinent cases so thoroughly treated by Judge Rich in the Papesch opinion. Of these cases Packer v. Marzall, 92 F. Supp. 736, 86 USPQ 446, seems to me to be very pertinent as applied to the present facts. There evidence of an unobvious advantage was found in the yellow azo dyes made from the claimed intermediates. Despite the fact, as stated by the board, that the decision was rendered "before the enactment of the statutory standard set forth in 35 U.S.C. 103", it seems to me to express a proper and workable view as to the evidence admissable for showing unexpected properties in a chemical compound.

In my opinion, the best evidence of the properties of the compound claimed here is to be found by testing the product made by that compound. I can conceive of no more convincing proof of unexpected and unobvious properties of the claimed intermediate than to show those unexpected and unobvious properties of the sulfa drug made therefrom.

I would therefore reverse the decision of the board.

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No. 466

In the Supreme Court of the United States

OCTOBER TERM, 1963

ALEXANDER R. SURREY, ET AL., PETITIONERS

v.

DAVID L. LADD, COMMISSIONER OF PATENTS

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF CUSTOMS AND PATENT APPEALS

BRIEF FOR THE RESPONDENT IN OPPOSITION

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JOHN W. DOUGLAS,
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OPINION BELOW

The opinion of the United States Court of Customs and Patent Appeals (Pet. 1a–8a) is reported at 319 F. 2d 233.

JURISDICTION

The judgment of the Court of Customs and Patent Appeals was entered on June 20, 1963 (Pet. 1a). The petition for a writ of certiorari was filed on September 12, 1963. The petitioners invoke the jurisdiction of this Court under 28 U.S.C. 1256 (Pet. 2).

QUESTIONS PRESENTED

1. Whether this Court has jurisdiction to review on certiorari a decision by the United States Court

of Customs and Patent Appeals which affirmed the denial of certain patent claims by the Board of Appeals of the United States Patent Office.

2. Whether, where the Patent Office holds that a new chemical product is patentable because it possesses an "unexpected pharmacological quality" so that the product would not have been obvious to one skilled in the art, it must also hold patentable a new but obvious material used in making the product as well as the process by which the product is made.

STATUTE INVOLVED

Act of July 19, 1952; § 103, 66 Stat. 798, 35 U.S.C. 103:

> § 103. Conditions for patentability; non-obvious subject matter
>
> A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

STATEMENT

Petitioners applied to the Patent Office for a patent (1) on certain chemical compounds known as carbamates and useful as local anesthetics, (2) on the process by which these carbamates are made and (3) on other compounds known as chloroformates which are used as intermediates or starting materials in the

making of the carbamates (Pet. 1a). As revealed by petitioners' claims, the chloroformates are reacted with an amine to produce the carbamates (Pet. 1a–4a). The Examiner allowed the claims to the final products, the carbamates, finding that they possessed "an unexpected pharmacological quality" not possessed by other carbamates (Pet. 3a). However, he disallowed the claims to the process and to the intermediate chloroformates, stating (Pet. 4a):

> Claims 10–14, drawn to process, are rejected as being unpatentable over the patent to Cusic which discloses a classic method of preparing carbamic acid esters by the reaction of an amine and a chloroformate. This process is considered obvious in the preparation of the carbamic acid esters on appeal and only the expected result is revealed in applicants' use of this process to prepare the compounds of the allowed product claims. Application of an old process to different but analogous material is not inventive.
>
> Claims 15–17, drawn to intermediary products, are rejected as being unpatentable over the reference to Beilstein which discloses 2,4 dimethylphenyl chloroformate, an isomer of the claimed intermediates.

When the Examiner's decision was upheld by the Board of Appeals of the Patent Office, the petitioners appealed to the United States Court of Customs and Patent Appeals (Pet. 1a).

The Court of Customs and Patent Appeals agreed with the Patent Office's conclusion that the petitioners' invention was contained solely in the final product claims. As to the claims to the chloroformates, the court noted that it was undisputed that they had a

sufficient structural similarity to other chloroformates disclosed in a previous patent so that there arose a prima facie case that they would have been obvious to a person having ordinary skill in the prior art (Pet. 5a). The court held the two affidavits which petitioners submitted in an attempt to overcome the prima facie case "insufficient" on finding that they "concern only the properties of the carbamates and in no way consider the properties of the claimed chloroformates" (Pet. 5a–6a).

For the process claims, the petitioners relied not upon evidence of their patentability standing alone but upon the fact that the final product was patentable and that one of the starting materials (the chloroformates) was new (although obvious) (Pet. 6a). The Examiner rejected the claims, noting that a previous patent to one Cusic disclosed "a process for preparing carbamac acid esters (carbamates) by heating an aryl chloroformate with an alkalene-diamine in an inert organic solvent," and that this is "a classic method of preparing carbamic acid esters" (Pet. 6a). On appeal, the court observed, "Appellants admit that Cusic discloses the same type of reaction as claimed * * *" (Pet. 6a). Then, applying the rule that the allowability of one set of claims cannot be predicated upon the patentability of other claims (Pet. 7a), the court affirmed the decision of the Patent Office (Judge Smith dissenting).

ARGUMENT

Recently this Court declined to rule on the question whether decisions of the Court of Customs and

Patent Appeals, in patent cases on appeal from the Patent Office, are reviewable on certiorari. *Glidden Company* v. *Zdanok*, 370 U.S. 530, 578, n. 49. In our view there is no need for the Court to rule on that question in this case, for the decision below is plainly correct on the merits. The Court properly applied the settled rule that the patentability of one set of claims cannot normally be predicated upon the patentability of another set. Where one product is used to make another product, the two products must be viewed separately in determining patentability. Similarly, process claims and claims for the resulting products are independent and must be considered separately.

1. We assume, in light of this Court's opinion in *Glidden Company* v. *Zdanok*, 370 U.S. 530, that there is no constitutional obstacle to review by this Court of patent rulings of the court below.[1] But the fact

[1] In *Postum Cereal Co.* v. *California Fig Nut Co.*, 272 U.S. 693, 698–699, this Court held that a decision of the Court of Appeals of the District of Columbia, on appeal from a decision of the Patent Office relating to a patent and trademark application, was not a judicial determination but "merely an instruction * * * by a court which is made part of the machinery of the Patent Office for administrative purposes." Since such a decision did not, in the Court's view, present a justiciable case or controversy, it was deemed beyond the constitutional powers conferred upon this Court.

The jurisdiction of the Court of Appeals for the District of Columbia over patent and trademark matters was subsequently transferred to the Court of Customs and Patent Appeals. Act of March 2, 1929, 45 Stat. 1475. But the nature of the proceeding was not changed, and thereafter, in denying certiorari in *Pacific Northwest Canning Co.* v. *Skookum Packers' Association*, 283 U.S. 858 (trademark case), and in *McBride* v. *People*, 311 U.S. 649

that the Court of Customs and Patent Appeals may now be viewed as an Article III court does not mean that certiorari jurisdiction automatically follows. It is necessary to establish that Congress intended to vest such jurisdiction in this Court.

To satisfy this jurisdictional prerequisite, petitioners invoke 28 U.S.C. 1256 which states: "Cases in the Court of Customs and Patent Appeals may be reviewed by the Supreme Court by writ of certiorari." Section 1256 is part of the Act of June 25, 1948, 62 Stat. 869, 928, codifying Title 28 of the United States Code. Prior to the codification, the only statutory provision authorizing this Court to review decisions of the Court of Customs and Patent Appeals was a provision relating to customs cases. That provision—Section 195 of the old Judicial Code (36 Stat. 1145), as amended—had two elements, one empowering the Court of Customs and Patent Appeals to hear appeals from the Customs Court in customs cases, and a second authorizing this Court to review such decisions. It did not refer to patent or trademark matters. The codification of Title 28 merely separated the foregoing two provisions, placing the former in 28 U.S.C. 1541 and the latter in 28 U.S.C. 1256.[2] However, nothing in the codifying Act of 1948 suggests that Congress had any intention of according power to review a class of cases over which jurisdiction had previously been withheld.

(patent case), the Court specifically noted that the denial was "for want of jurisdiction" citing *Postum Cereal*. In subsequent patent cases, the Court has merely denied certiorari, without more.

[2] The Revisers Notes to Sections 1256 and 1541 confirm the derivation of those provisions.

Stern and Gressman, *Supreme Court Practice* (3d ed. 1962), Sec. 2–22.

2. On the merits, both the Patent Office and the Court of Customs and Patent Appeals found that the petitioner's chloroformates and the process of reacting chloroformates with an amine to produce carbamates would have been obvious to one skilled in the art (Pet. 4a–8a). Petitioners do not dispute this finding, and rest their claims essentially upon the patentability of the final product made by the process. Long ago, however, in *Rubber Co.* v. *Goodyear*, 9 Wall. 788, 796, the Court clearly rejected this contention,[3] indicating that where one product is made by using another, either one may be patentable, depending upon the standards of patentability as applied to each product independently and that the same rule applies to the process or method by which the product is made. See *Cochrane* v. *Deener*, 94 U.S. 780, 787–788; *Expanded Metal Co.* v. *Bradford*, 214 U.S. 366, 381–386; *In re Cady*, 77 F. 2d 106, 109

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[3] The Court stated (9 Wall. at 796):

"A machine may be new, and the product or manufacture proceeding from it may be old. In that case the former would be patentable and the latter not. The machine may be substantially old and the product new. In that event the latter, and not the former, would be patentable. Both may be new, or both may be old. In the former case, both would be patentable; in the latter neither. The same remarks apply to processes and their results. Patentability may exist as to either, neither, or both, according to the fact of novelty, or the opposite. The patentability, or the issuing of a patent as to one, in nowise affects rights of the inventor or discoverer in respect to the other. They are wholly disconnected and independent facts. Such is the sound and necessary construction of the statute."

(C.C.P.A.); *Buono* v. *Yankee Maid Dress Corp.*, 77 F. 2d 274, 279 (C.A. 2); *Bauer Bros. Co.* v. *Bogalusa Paper Co.*, 96 F. 2d 991, 994 (C.A. 5); *Oxford Varnish Corp.* v. *General Motors Corp.*, 120 F. 2d 44, 47 (C.A. 6); *Binney & Smith Co.* v. *United Carbon Co.*, 125 F. 2d 255, 258 (C.A. 4); *Application of Larsen*, 292 F. 2d 531 (C.C.P.A.), certiorari denied, *sub nom. Larsen* v. *Ladd*, 370 U.S. 936. These holdings leave no doubt, as the Court of Customs and Patent Appeals has said, that "It is well settled that the allowability of one set of claims cannot be predicated on the patentability of other claims in the same application." *Application of Touvay*, 264 F. 2d 901, 903.

Petitioners assert a conflict between the decision below and this Court's observation in *James* v. *Campbell*, 104 U.S. 356, 377, "Where a *new* process produces a *new* substance, the invention of the process is the same as the invention of the substance * * *." [Emphasis supplied.] However, the Court was there speaking of the unusual situation where a novel product and the novel process by which it is made are logically inseparable and where, viewing the invention either as one for a process or for the resulting product, sufficient novelty exists for patentability. This, however, is not the case at bar. Both the Patent Office and the court below found as a fact that the petitioners' process claims were obvious to one skilled in the art and petitioners have not even attempted to show that this finding is factually erroneous. Moreover, the Court in *James* v. *Campbell*, 104 U.S. at 377, emphasized that normally processes and related products are independant and each must stand or fall on

its own. See also *Holland Fur. Co.* v. *Perkins Glue Co.*, 277 U.S. 245, 255–256.

There is no merit to petitioners' argument that an interpretation of 35 U.S.C. 103 (*supra*, p. 2) is here involved; and that the rejection of petitioners' process claims, while at the same time allowing their product claims, is inconsistent with the statute. It is clear from the terms and the legislative history[4] of Section 103, enacted in 1952, that its purpose was to codify a rule designed to limit the type of claim on which a patent may be granted and that it did not change the established law that process claims and claims to the resulting product are normally independent with

[4] The Committee Report accompanying the bill to revise and codify Title 35 of the United States Code, stated (H. Rep. No. 1923, 82d Cong., 2d Sess., p. 7):

"Section 103, for the first time in our statute, provides a condition which exists in the law and has existed for more than 100 years, but only by reason of decisions of the courts. An invention which has been made, and which is new in the sense that the same thing has not been made before, may still not be patentable if the difference between the new thing and what was known before is not considered sufficiently great to warrant a patent. That has been expressed in a large variety of ways in decisions of the courts and in writings. Section 103 states this requirement in the title. It refers to the difference between the subject matter sought to be patented and the prior art, meaning what was known before as described in section 102. If this difference is such that the subject matter as a whole would have been obvious at the time to a person skilled in the art, then the subject matter cannot be patented.

"That provision paraphrases language which has often been used in decisions of the courts, and the section is added to the statute for uniformity and definiteness. This section should have a stabilizing effect and minimize great departures which have appeared in some cases."

To the same effect, see S. Rep. 1979, 82d Cong., 2d Sess., p. 6.

respect to patentability. Section 103 provides that, even if there are differences between the subject matter of the claims and the prior art, a patent shall not issue if the "subject matter as a whole would have been obvious" to a person skilled in the art. Certainly, this does not support the contention that a process, obvious to one skilled in the art, is patentable merely because the resulting product is patentable.[5]

CONCLUSION

The petition for a writ of certiorari should be denied.

Respectfully submitted.

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[5] Petitioners also assert a conflict between the decision below and *Parker* v. *Marzall*, 92 F. Supp. 736 (D.D.C.). However no conflict is apparent from the district court's opinion in that case. In *Parker*, the court did hold that in the case before it, the evidence at trial showed that an intermediate compound, used in making certain dyes, was patentable over the prior art which disclosed a structurally related compound. The court also held that evidence dealing with the final product was "proper evidence as to the properties possessed" by the intermediate (*id.* at 738). However, what other evidence was introduced as to the patentability of the intermediate is not detailed in the court's opinion. The court did not hold that just because a final product has unexpected properties, an intermediate from which it is made is *ipso facto* patentable over the prior art showing a structurally related compound.

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